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10/715,669

11/18/2003

Jerome Glasser

4813

40232

7590

02/22/2005

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EXAMINER

SANDY, ROBERT JOHN

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,669

Applicant(s)

GLASSER, JEROME

Examiner

Robert J. Sandy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 7) ☐ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an enabling disclosure teaching how to make the claimed invention, as to the following: The specification fails to provide an enabling disclosure teaching how to make the claimed device having subject matter pertaining to the device wherein the “means for maintaining at least one substantially planar display item in contact with said at least a first planar member is a glue-like element” (claim 2) and “is sonic-welding” (claim 4), wherein the “at least first planar element is of plastic” and “is metal” (claim 5), and wherein the “at least one raised portion is of plastic” (claim 2) and “of metal” (claim 5).

The disclosure is objected to because of the following informalities: The spacing of the lines on the pages of the specification containing the section labeled “Brief Description of the

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Drawings” is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide antecedent basis for the claimed subject matter pertaining to:

a "means for maintaining at least one substantially planar display item in contact with said at least a first planar member" (claim 1).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature of “a glue-like element” (claim 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1, 6 and 11, are objected for improper claim language because the claim preamble ("For holding at least one item") in each of these claims does not establish any single category of invention necessary to define the intended invention. Furthermore, each of claims 1, 6 and 11 fail to include a transitional term, such as "comprising", "consisting essentially of" and "consisting of" in order to define the scope of the claim(s) with respect to what unrecited additional components, if any, are excluded from the scope of the claim. (An acceptable preamble may be *A device for holding at least one item, comprising:*) For the purposes of this Office action, the claims have been considered to be inclusive or open-ended and does not exclude additional, unrecited elements. Appropriate correction is required.

Claims 9 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 9 is improper for being dependant on itself (i.e., claim 9). Accordingly, the claims 9 and 10 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed subject matter pertaining to the device wherein the "means for maintaining at least one substantially planar display item in contact with said at least a first planar member is a glue-like element" (claim 2) and "is sonic-welding" (claim 4), wherein the "at least firs planar element is of plastic" and "is

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metal” (claim 5), and wherein the “at least one raised portion is of plastic” (claim 2) and “of metal” (claim 5).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5, 7 and 8 (through 10) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as to the following:

In each of claims 2-5, 7 and 8, there is no antecedent basis for "The device and system".

In claims 2, 4, 5, there is no antecedent basis for "said means for maintaining at least one raised portion . . ."

Claims 3, 4, 5, and 7 (and 9) are each indefinite for being incomplete since each of these claims do not end with a period.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (U. S. Patent No. 4,947,524). Chang ('524) discloses a device (clip 4) for holding an item (P), comprising: at least a first planar member (42) having a first surface and a second surface opposing one another; at least one raised portion (portion S1) in perpendicular contact with at least a surface (S2) of said at least a first planar member, means (curved closed end if the clip) for maintaining at least one substantially planar display item in contact with said at least a first planar member;

(concerning claim 6) a device having at least a first planar member (42) having a first surface and a second surface opposing one another, at least a second planar member (41) having

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a first surface and a second surface opposing one another; at least one raised portion (S1) in perpendicular contact with at least a surface (S2) of said at least a first planar member, means (curved closed end if the clip) for maintaining at least one substantially planar display item in contact with said at least a first planar member;

(concerning claim 11) device (clip 4) for holding an item (P), comprising: at least a first planar member (41) having a first surface and a second surface opposing one another; at least a second planar (42) member having a first surface and a second surface opposing one another; means (curved closed end if the clip) for maintaining at least a portion of said at least a first planar member and said at least a second planar member in contact with each other so that a pressure tension is created in a defined cavity (cavity defined between 41 and 42) formed between said at least a first planar member and said at least a second planar member and suitable for receiving the introduction of at least one substantially planar display item (P).

Claims 1, 6, 7, 8, and 11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hunt et al. (U. S. Patent No. 5,697,131). Hunt et al. ('131) a device (10) for holding an item, comprising: at least a first planar member (12) having a first surface and a second surface opposing one another; at least one raised portion (lip 18) in perpendicular contact with at least a surface of said at least a first planar member, means (16) for maintaining at least one substantially planar display item in contact with said at least a first planar member;

(concerning claim 6) a device (10) having at least a first planar member (12) having a first surface and a second surface opposing one another, at least a second planar member (14) having a first surface and a second surface opposing one another; at least one raised portion (18) in perpendicular contact with at least a surface of said at least a first planar member, means (16) for maintaining at least one substantially planar display item in contact with said at least a first planar member;

(concerning claim 7) the at least a first planar member is of plastic ("plastic", see col. 4, line 60); and the at least a second planar member is of plastic ("plastic", see col. 4, line 60);

(concerning claim 8) the at least one raised portion in perpendicular contact with at least a surface of said at least a first planar member is integrally molded of plastic; means for maintaining at least one substantially planar display item in contact with said at least a first

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planar member is tension created in a defined cavity formed between said at least a first planar member and said at least a second planar member suitable for receiving the introduction of at least one substantially planar display item;

(concerning claim 11) device (10) for holding an item (P), comprising: at least a first planar member (12) having a first surface and a second surface opposing one another; at least a second planar (14) member having a first surface and a second surface opposing one another; means (16) for maintaining at least a portion of said at least a first planar member and said at least a second planar member in contact with each other so that a pressure tension is created in a defined cavity (cavity defined between 12 and 14) formed between said at least a first planar member and said at least a second planar member and suitable for receiving the introduction of at least one substantially planar display item.

Allowable Subject Matter

Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

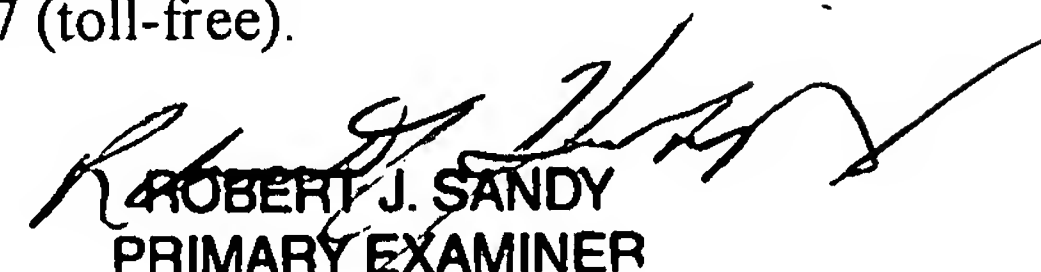
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art holding device are demonstrated by Lawrence (U. S. Patent No. 6,457,218), Royer (U. S. Patent No. 6,018,849), Bonnet 9u 2,742,911), McDonald (U. S. Patent No. 487,959), Sampson (U. S. Patent No. 1,294,954), Koutras et al. (U. S. Patent No. 6,718,709), Burkard et al. (U. S. Patent No. 5,121,526), and Cheng (U. S. Patent No. 4,793,725).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is 703-305-7413. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ROBERT J. SANDY
PRIMARY EXAMINER